

The Making of Modern Trade Marks Law: The Construction of the Legal Concept of Trade Mark (1860-80)

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Although some accounts of the history of trade marks law trace the origin of trade mark protection to Greek or Roman times,¹ and other accounts of the British history locate the origins of British trade mark law in the Medieval guilds,² or the sixteenth century case of *Sothorn v How*,³ British trade marks law did not really take anything like its modern shape until the middle of the nineteenth century.⁴ The period between 1860-1910 witnessed the development of many of the characteristic features of modern trade marks law: a legal understanding of a trade mark as a sign which indicates trade origin;⁵ the establishment of a central registry in 1875; the

¹ E.g. W Robertson, 'On Trade Marks' (1869) JSA 414

² Most famously, Schechter, *The Historical Foundations of the Law Relating to Trade-Marks* (New York: Columbia, 1925). He traces the development of the modern trade mark to two pre-cursors: the 'proprietary mark' or 'merchants mark', which indicated ownership of the goods, and the 'regulatory' or 'production' mark. The latter, often used under the mandatory requirements of the guilds (even as late as the seventeenth century), was transformed from a 'liability mark' to an 'asset mark', (particularly in the cloth and cutlery trades) according to Schechter, not by virtue of the common law but under guild jurisprudence (as well as that of the Star Chamber and Privy Council). For Schechter, the dominance of the guild structures, their systems of resolving disputes, and their prohibitions of litigation go a long way to explain the lack of litigation in the courts and reported case law concerning trade marks prior to the nineteenth century. As guild structures broke down, protection for trade marks would be provided, if at all, from statutes and case law. This did not occur in earnest until the nineteenth century, he argues, because "trade-marks did not develop as valuable symbols of good-will so long as producer and consumer were in close contact." (See pp. 17-18; 129).

³ (1656) Pop R. 144. John Baker has identified the earlier case as *JG v. Samford*. Schechter, *The Historical Foundations of the Law Relating to Trade-Marks* (New York: Columbia, 1925) argues that *Southern v How* is a dubious authority for the modern law of passing off: "the sole contribution of that case was at best an irrelevant dictum of a reminiscent judge that he remembered an action by one clothier against another for the mis-use of the former's trade-mark" (p. 123).

⁴ F.M. Adams, *A Treatise on the Law of Trade Marks* (London: 1874) p. 3 (law of trade marks "much more recent" than that of patents "being almost exclusively the growth of the last seventy or eighty years"); E.M. Daniel, *The Trade Mark Registration Act* (London: Stevens & Haynes, 1876) p. 1 ("The law by which property in trade marks is recognised and protected is of very recent origin...It was not until the present century that the principles upon which such property rests were ascertained and understood, and it is only in the last thirty years that cases upon the subject have become at all frequent or important"); D. Kerly (1894) p. 2 ("The law on this subject cannot be traced back further than the present century"); Ludlow & Jenkyns (1873) at 10 ("The first reported case of any real importance was decided by Lord Mansfield in 1783": i.e. *Singleton v. Bolton*, 3 Douglas 293); Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (3rd ed. London: Sweet & Maxwell, 2004) 29 ("The last quarter of the nineteenth century was the time when passing off came of age.")

⁵ Kerly (1894) 5 (a "symbol expressly adopted by the plaintiff to distinguish his goods and identify them with him.")

conceptualisation of the trade mark as an object of property;⁶ the recognition of a dual system of protection, one based on registration, the other without, based on use in the market-place; and the development of international arrangements for the protection of marks in foreign territories. Looking back from the early 21st century it is clear that, while there were significant developments in trade marks law in the period before 1860 and the period after 1910, the majority of the most salient features of the current trade mark regime were developed (or if not developed, institutionalised) in this period of intense legislative, judicial, diplomatic and scholarly activity. Although all these developments were intertwined, time and space only permits this paper to attempt chart one of these developments: the genesis of a legal conception of ‘a trade mark’ in the first part of this period.

1. The Situation in Mid-Century

At mid-century, as the law of designs, patents and copyright were crystallizing,⁷ there was no [coherent] law of trade marks. Giving evidence to the Select Committee of 1862, solicitor Joseph Travers Smith complained of the “very considerable” evils of the existing law.⁸

“They arise from the fact that trade marks are not recognized as having any legal validity or effect; that there is no written law on the subject of trade marks, and we have consequently no definition by which we can try what a trade mark is, nor consequently what particular symbol amounts to a trade mark”.

Indeed, while at this stage we see the publication of textbooks on copyright, designs and patents,⁹ there were no textbooks on ‘trade marks’. Although the term ‘trade mark’ had been present in some of the cases,¹⁰ there was no consensus as to what a trade mark was, nor of what a ‘law of trade marks’ would look like. In fact, we can probably say that, as of 1850, it made no sense to talk of ‘a law of trade marks’ in the UK.

⁶ Kerly (1894) (“recent decisions...vindicate the principle that the right of property in trade-marks does not depend on registration.”)

⁷ B. Sherman & L. Bently, *The Making of Modern Intellectual Property Law* (Cambridge: CUP, 1999), Chs 5-7.

⁸ Select Committee, Q. 2619 (Travers Smith).

⁹ Textbooks on these areas emerged from the 1820s. Works on copyright included those by Maugham, Underdown, Phillips; textbooks on patents were written inter alia by Hindmarch; a combined work on patents and copyright by Godson; and a text on designs by T. Turner.

¹⁰ *Collins Co v Brown* (1857) 3 K&J 423, 426 (Page-Wood V-C); *Dixon v Fawcus* (1861) 3 El & El 537, 546 (Crompton J.); *Dent v Turpin* (1861) 2 J & H 139

To say there was no law of trade marks is not to say that there were no laws regulating misrepresentation in trade. However, the protection afforded to traders who found they were victims of the fraudulent imitation of their names and marks was fragmented, drawing on a variety of jurisdictional sources, some statutory and some based on judicial precedent, and lacked any abstract logic. The statutory systems tended to be confined to specific trades: under this heading, there was the protection of the marks of makers of knives, sickles, sheers, scissors and other Cutlery Wares in Hallamshire by registration with the Cutlers Company of Sheffield;¹¹ the protection given over use of the sign LONDON under the Cutlery Trade Act;¹² the protection of marks woven into and fixed on linen;¹³ protection of the names of patentees;¹⁴ protection of marks used in the hop trade;¹⁵ of marks on gun barrels;¹⁶ of hall marks on gold and silver wares.¹⁷ In addition, there was regulation of the use of family crests and insignia under the law of heraldry and arms. In certain cases, there was the possibility of criminal actions based on forgery,¹⁸ cheat,¹⁹ conspiracy to defraud,²⁰ or obtaining benefits by false pretences.²¹ Another possibility, attempted by some, was

¹¹ Act for the good Order and Government of the Makers of Knives, Sickles, Sheers, Scissors and Other Cutlery Wares 21 Jac 1 c. 31 (1623); 31 Geo 3 c 58 (1791); 41 Geo 3 c. 97 (1801); 54 Geo 3 c. 109 (1814); 23 & 24 Vict. C. 43 (1860).

¹² Act to Regulate the Cutlery Trade in England (1819) 59 Geo 3, c.7 (limiting the legitimate use of hammer symbols to hand-made cutlery; and prohibiting the use of the word London other than on cutlery made within 20 miles of the City of London)

¹³ Linen Act (1726) 13 Geo 1, c.26 s.30 (authorising weavers of linens to weave name into wares and to fix “some known mark” on pieces of linen manufacture, and punishing counterfeiting of such name or mark).

¹⁴ Patent Law (Amendment) Act (1835) 5 & 6 Wm 4, c.83, s.7 (prohibiting the marking of goods with the name, stamp, mark or other device of patentee, and use of the word PATENT).

¹⁵ Hops (Prevention of Frauds) Act 1866, 29 & 30 Vict. c. 37 (repealing and replacing (1814) 54 Geo. 3 c.123). The 1866 Act uses the term “trade mark”.

¹⁶ (1813) 53 Geo 3, c. 115, s. 9 (relating to unauthorised counterfeiting of ‘mark’ or ‘stamp’ on any gun, fowling piece, blunderbuss, pistol or other description of arms usually called small arms).

¹⁷ Act to amend Laws in Force for Preventing Fraud and Abuses in the Making of Gold and Silver Wares in England (1844) 7 & 8 Vict. c.22 (repealing and replacing (1798) 38 Geo. 3 c. 69, s.7).

¹⁸ *R v Closs*, (1857) Dearsley & B 460, 27 LJMC 54; *R v Smith*, (1858) Dearsley & B 566, 27 LJMC 225 (not forgery because baking powder wrappers were not documents or instruments). Forgery was placed on a statutory footing in the codification of 1861: 24 & 25 Vict. c. 98.

¹⁹ *R v Closs*, (1857) Dearsley & B 460, 27 LJMC 54 (per Cockburn CJ). This case concerned a copy of a painting by John Linnell, which the defendant had sold bearing a signature purporting to be that of Linnell. The Court held that this could not be a common law forgery, because a forgery “must be of some document or writing” but could be a cheat, describing the scope of “cheat” to encompass the placing of “a false mark or token upon an article, so as to pass it off as genuine one when in fact it was only a spurious one, and the article was sold and money obtained by means of that false mark or token”. On the facts, the prosecution had not demonstrated that the purchaser bought the painting on the basis of the signature.

²⁰ Select Committee, 2273 (J. Dillon)

²¹ 7 & 8 Geo. 4 c. 29, s.53 (offence of obtaining money by false pretences); (1861) 24 & 25 Vict. c.96, ss.88-90. *R v Smith*, (1858) Dearsley & B 566, 27 LJMC 225 (per Pollock CB, Willes J. and Chanell B.: D’s labelling of its product as BORWICK’S BAKING POWDERS was not a forgery but was obtaining

to try and register labels as designs or, after 1862, with the Stationers Company, so as to claim copyright protection.²² Most importantly, there were the general actions at Common Law and in Equity: the action on the case for deceit at Common Law, which had, at least since *Sykes v. Sykes* in 1824 been available for cases involving use of marks on goods with intent to deceive;²³ and an action in Equity ancillary to the common law action for deceit, under which the Court of Chancery would grant injunctive relief pending establishment of the claimant's rights at law.²⁴ From 1839, with the case of *Millington v. Fox*,²⁵ the action in Chancery seemed to have made a tentative move towards an independent status, insofar as relief was made available without evidence of intent to deceive.

By the 1850s, the complex state of the law had become a real cause of inconvenience and expense to traders who wished to gain protection in the United Kingdom.²⁶ Moreover, the complexity of the law also was seen as an impediment to attempts to gain protection for British traders abroad. And there were certainly a sense that British traders needed protection abroad, as the markets for their goods, both in the UK, the British colonies and elsewhere, were being penetrated by counterfeit goods originating outside the UK. If British traders were to get protection in other European countries, the United States, Russia – the countries where counterfeit goods originated or were sold – then some form of international arrangement was almost certainly necessary. And British traders foresaw that it would be difficult to base any arrangement of a principle of reciprocity when British law itself was so difficult to comprehend and expensive to apply.²⁷

money by false pretences); *R v Dundas* (1853) 6 Cox Crim Cas 30 (Erle J., Northern Circuit) (2 years imprisonment for obtaining money by false pretences where D had sold 72 bottles of blacking marked EVERETT'S PREMIER in labels imitating Everett's labels); *R. v. Suter & Coulson* (1867) 10 Cox Crim Cas 577 (pawning watch with false mark of Goldsmith's Company was obtaining money by false pretences). cf. *R v Bryan* (18xx) 7 Cox Crim Cas 312 (representing that spoons were 'equivalent to ELKINGTON'S A' was exaggeration as to quality and not a false pretence). See also, Select Committee, Qs. 2747-8 (Travers Smith).

²² Select Committee, 2465 (Browning).

²³ E.g. *Morison v Salmon* (1841) 2 Man & G 385 ("Morison's Universal Medicine"); *Crawshay v. Thompson* (1842) 4 Man & G 357 ("WC" in oval on iron); *Rodgers v Nowill* ("J. Rodgers & Sons" on pen-knives)

²⁴ *Motley v Downman* (1837) 3 My & Cr 1, 14 per Lord Cottenham LC.

²⁵ (1838) 3 Myl & Cr 338; 40 ER 956.

²⁶ On the expense of litigation see Select Committee Qs 1681-1683 (D. Sinclair); 1970, 1987 (Polson); 2450-3 (Morley); 2503; 2511 (Coxon); 2613 (Joseph Travers Smith).

²⁷ See, L. Levi, 'On Trade Marks' (1859) JSA 262, 265 (explaining that the French law of 1857 would only protect foreigners where a treaty existed between France and the relevant country affording reciprocal protection to French traders); Select Committee, Q. 2619 (Travers Smith) ("the defective

2. The Development of a Law of Trade Marks, 1860-1880

The period from 1860 to 1880 was one of particularly intense activity in relation to trade mark law. Although there had long been complaints about the prevalence of misleading use of trade marks,²⁸ little effort had hitherto been made to develop the law.²⁹ This changed in the late 1850s, when the Chambers of Commerce around the UK started to involve themselves in an attempt to procure legislation.³⁰ The case was made for amendment of the law in arenas such as the Royal Society of Arts,³¹ National Association for the Promotion of Social Science,³² as well as provincial law societies.³³ Having determined that some kind of reform was essential, the Chambers of Commerce engaged lawyers to draft legislation,³⁴ which was presented to the government. In 1861, the first Bill dealing with the matter was introduced by Lord

condition of the English law prevents foreign governments from giving any remedy, because there is no sufficient reciprocity in England.”)

²⁸ “Instances of tradesmen endeavouring to obtain an advantage to themselves by the use of the name and reputation of others, have, unfortunately, of late become too common.” Lord Langdale MR in *Franks v Weaver* (1847) 10 Beav 297, 302 (medicine case); ‘Proposed Alterations in the law of Trade Marks’ (1861) *Sol Jo & Rep* 2 (“Great anxiety has been displayed for some years past to have the law of trade marks placed upon a footing that would secure the rights of the manufacturer and guard the interests of the public”); Select Committee, Q. 2754-5 (Hindmarch) (“the frauds were very extensive; and that they had been going on increasing, and now they were greater than they ever were. It is a sort of gangrene, which is really eating the vitals of our manufactures...[and] destroying our credit, not only at home, but abroad”); HB Poland, *The Merchandise Marks Act 1862* (London: J Crockford, 1862) 5: “For years past it has been felt that the legislature must sooner or later interfere for the purpose of preventing the forgery of trade marks and the false marking of merchandise...”

²⁹ But note F Crossley’s claim to the meeting of the Association of Chambers of Commerce on Feb 6, 1861, that “deputation after deputation from Sheffield had been before the Government on that subject [trade marks], but without effect.” See ‘Association of Chambers of Commerce’, *The Times*, Feb 7, 1861 p. 12f. ‘Proposed Alterations in the law of Trade Marks’ (1861) *Sol Jo & Rep* 2 (“There have been numerous deputations upon the subject to the President of the Board of Trade...”)

³⁰ ‘Trade Marks’ (1858) JSA 595 (August 20, 1858) (reporting meeting of Birmingham Chamber of Commerce unanimously approving motion that improper use of trade marks was wrong and should be discouraged in every way by the Chamber.) On the influence of chambers of commerce, see Ilersic & Liddke, *Parliament of Commerce: the Story of the Association of British Chambers of Commerce* (1960). G. R. Searle, ‘The development of Commercial Politics, 1850-70’ Ch 5 in *Entrepreneurial politics in mid-Victorian Britain* (1993) NF4 544.7.c95.75.

³¹ Professor Leone Levi, an academic and barrister active in the Associated Chamber of Commerce, gave a significant paper at the Fifteenth ordinary meeting of the Royal Society of Arts on March 16, 1859: see (1859) JSA 262.

³² A. Ryland, ‘The Fraudulent Imitation of Trade Marks’, (1859) *Transactions of the National Association for the Promotion of Social Science* 229, with responses at 269

³³ See ‘On Fraudulent Trade Marks’, (1861) *Sol Jo & Rep* 820 reporting paper of John Morris given to the Metropolitan and Provincial Law Association, Worcester; and ‘The Registration of Trade Marks’ (1861) *Sol Jo & Rep* 839 reporting paper by Arthur Ryland to the same Association.

³⁴ ‘State of Trade’, *The Times*, December 3, 1860 p. 4f (reporting meeting of representatives of Sheffield and Wolverhampton Chambers of Commerce with the Birmingham Chamber and consequent resolution that the Sheffield Chamber should prepare a Bill to provide for the registration of trade marks at home, as well as to empower the Crown to conclude conventions with foreign powers for reciprocal protection).

Campbell into the House of Lords,³⁵ but ultimately was not proceeded with beyond the Committee stage in the Commons. By this point, the Government had decided that a Select Committee of the House should be convened to consider the matter carefully.³⁶ So, in February 1862, following the introduction of a Government Bill on ‘merchandise marks’,³⁷ and a private members bill on ‘Trade Marks’ (drafted by solicitor William Smith on behalf of the Sheffield Chamber of commerce and introduced by John Arthur Roebuck, MP for Sheffield),³⁸ a Committee was convened.³⁹

The Select Committee, comprising “lawyers and mercantile men of great experience and representing different interests”,⁴⁰ met and heard evidence from a wide range of traders (file makers, edge tool manufacturers, cutlery manufacturers, gun makers, thread manufacturers, needle makers, button makers, lace makers, starch and confectionery makers, brewers, paper makers), merchants,⁴¹ bureaucrats,⁴² and lawyers.⁴³ Following its deliberations it was decided – not it seems unanimously - to pursue the Government Bill,⁴⁴ and this was done, so that in 1862 the Merchandise Marks Act was passed. This Act created criminal offences for uses of misdescriptions in trade with intent to defraud, and specifically referred to misuse of trade marks,

³⁵ Bill 1861 (based on Bill by Travers Smith on behalf of Chambers of Commerce). Hansard, (1861) 161 *Parliamentary Debates* 327 (February 12, 1861); 1272 (March 4, 1861); 1940 (March 14, 1861); 2153 (March 18, 1861); Hansard, (1861) 162 *Parliamentary Debates* 543 (April 15, 1861); Hansard, (1861) 164 *Parliamentary Debates* 1089 (July 18, 1861).

³⁶ Hansard, (1861) 164 *Parliamentary Debates* 1089 (July 18, 1861); (1861) 165 *Parliamentary Debates* 274 (Feb 14, 1862).

³⁷ Hansard, (1862) 165 *Parliamentary Debates* 988 (March 3, 1862).

³⁸ Hansard, (1862) 165 *Parliamentary Debates* 442 (Feb 18, 1862), 770 (Feb 26, 1862).

³⁹ Hansard, (1862) 165 *Parliamentary Debates* 1231 (March 7, 1862); 1280 (10 March 1862), 1489 (13 March 1862). Roebuck resisted particularly the edition of Moffatt.

⁴⁰ Poland, 7. Chaired by John Arthur Roebuck, MP for Sheffield, the Committee comprised three barristers (Selwyn and Hugh Cairns, Sir Francis Goldsmid, a lawyer and MP for Reading), two members of the government (Milner Gibson, President of the Board of Trade, and Sir William Atherton, the Attorney General), manufacturers (Sir Francis Crossley, a carpet manufacturer; Alderman William Copeland, a pottery manufacturer and MP for Stoke; Edmund Potter, a calico printer and MP for Carlisle); George Moffatt, a tea-broker and MP for Southampton; Crum Ewing. Selwyn, who generally appeared before the Master of the Rolls, was counsel in *Hall v Barrows*, *Bury v Bedford*, *In re Uzielli*.

⁴¹ R Smith and J Dale of Westhead and J Dillon of Morrison, Dillon & Co, H Browning. WH Teulon, and Adolphus Baker, hop merchants. Some of the merchants actually dissented from the dominant assumption the trade marks were of public benefit. Dillon, for example was concerned about the proliferation of marks introducing “obstructions to business”. Select Committee, Q. 2268 (Dillon, in response to a question from Moffatt.)

⁴² George Wilkinson, the master cutler of the Cutlers Company; Bennet Woodcroft, Superintendent of Specifications in the Patent Office; and Lewis Edmunds, Clerk of the Patents.

⁴³ William Smith, Arthur Ryland, Joseph Tavers Smith, and William Hindmarch QC.

⁴⁴ Hansard, (1862) 167 *Parliamentary Debates* 1418 (July 4, 1862).

which were defined broadly to encompass “any Name, Signature, Word, Letter, Device, Emblem, Figure, Sign, Seal, Stamp, Diagram, Label, Ticket or other Mark of any other Description lawfully used by any person to denote any chattel, to be the Manufacture, Workmanship, Production or Merchandise of such Person.”

While the 1862 Act was welcomed in many quarters as a great improvement,⁴⁵ it was recognised as being of limited value particularly because liability was dependent on a demonstration of intent to defraud.⁴⁶ Moreover, the Act treated fraudulent use of trade marks as just one type of fraudulent trade practice, failing thus either to establish the trade mark as property, nor even recognise its specific characteristics. Not surprisingly, therefore, the Chambers of Commerce and Royal Society of Arts persisted in lobbying for a registration system.⁴⁷ This resulted in Bills being introduced into Parliament in 1869,⁴⁸ 1873,⁴⁹ and finally – and successfully in 1875.⁵⁰ The 1875 Act established a registration system for trade marks, and made the existence of such registration equivalent to public use. This, it was anticipated, would save traders the expense of establishing rights in the mark every time legal action was taken, as well as allowing all traders to know what marks had been protected.

⁴⁵ Poland; W Robertson, ‘On Trade Marks’ (1869) JSA 414, 415 (“This Act as much remedied the evils, and simplified the whole matter... There is no question or doubt that the Merchandise Marks Act has been of great public service”); E. Johnson, ‘Trade Marks’ (1881) 29 JSA 493, 505 (“That Act has proved most useful, by its deterrent effect, although the number of cases in which it has been put into operation have been but few.”)

⁴⁶ J. Salaman p. 3 (describing the Act as “less useful than might have been expected”); Kerly (1894) 7 (Act “of little practical service”).

⁴⁷ Association in Birmingham (1866) 14 JRSA 131; RSA TM Cttee established Feb 16, 1866; ‘Birmingham Chamber of Commerce’, *The Times*, August 2, 1872, p.12e; ‘Associated Chambers of Commerce’, *The Times*, Sept. 24, 1873, p. 12c.

⁴⁸ 1868-9 Bill No 126 (May 13, 1869; withdrawn, July). John Bright and Mr Shaw-Lefevre: *Times*, June 8, 1869, p. 12e. Two years later it was said that the earlier Bill which represented the Board of Trade’s views received “a very cool reception in the House”: (1871) 204 *Parliamentary Debates* 1387 (6 March, 1871). A Bill was also drawn up in 1866 by E M Underdown.

⁴⁹ Chichester Fortescue (Lord Carlingford) and Arthur Peel. Bill no 133. It received a first reading on April 21, 1873 and was withdrawn on July 7, 1873. Sampson Lloyd commented that “the opposition of one member of the house was sufficient to prevent it being proceeded with”: *The Times*, September 24, 1873, p. 12c.

⁵⁰ Introduced by Lord Cairns on June 22 the Act received Royal assent on August 13. See Hansard, (1875) 225 *Parliamentary Debates* 155 (July 15, 1875); (1875) 226 *Parliamentary Debates* 703 (Aug 7, 1875). *The Times*, September 10, 1875 p, 8a.

Mundella MP explained that the Act was “only saved from the Massacre of innocents by leaving out the regulations...” Bryce too took the view that the 1875 Act was shorter than earlier bills and “probably owes its success to this brevity”.

Although the two Acts and the Select Committee constitute key developments in the period, trade mark protection was being developed apace in other fora.⁵¹ The 1860s witnessed a surge in case law on trade marks, perhaps in part facilitated by the progressive reforms of the judicial system (in particular the procedural rules applicable in the courts of Equity).⁵² Vice-Chancellor Page Wood gave decisions in *Flavel v Harrison*,⁵³ *Farina v Silverlock*,⁵⁴ *Welch v Knott*,⁵⁵ *Mappin v Mappin* (1860),⁵⁶ *Woolam v Ratcliff* (1863),⁵⁷ *Batty v. Hill*,⁵⁸ *Braham v Bustard*,⁵⁹ *M'Andrew v Basset*,⁶⁰ *Ainsworth v Walmsley*;⁶¹ *Blackwell v Crabb*,⁶² *Morgan v M'adam*,⁶³ and, as Lord Hatherley, the Lord Chancellor (from 1868-72) in *Wotherspoon v Currie*,⁶⁴ Richard Bethell, as Lord Chancellor Westbury (1861-65) gave decision in *Edelsten v Edelsten*,⁶⁵ *Hall v Barrows*,⁶⁶ *M'Andrew v Basset*⁶⁷, as well as in the House of Lords in *Leather Cloth* and *Wotherspoon v Currie*;⁶⁸ Sir John Romilly MR gave rulings in *Bury v Bedford*,⁶⁹ *Hall v Barrows*,⁷⁰ *In re Uzielli*; *Ponsardin v Peto*,⁷¹ *Moet v Couston* (1864),⁷² *Colonial Life Assurance Co v The Home and Colonial Life*

⁵¹ “Lord Langdale, Lord Cranworth and Lord Justice Mellish had given...recognition to the Law of Trade Marks, and Lord Westbury and Sir William Page-Wood, afterwards Lord Hatherley, had finally established the rights of owners of Trade Marks. The nature of this property being once established, the next step was to give it statutory recognition, and supply facilities for securing it protection, and this Lord Cairns undertook in the Trade Marks Act 1875, which for the first time established a system of Registration of Trade Marks in accordance with the practice of Foreign countries, in which perhaps English Trade Marks are, from the reputation of the English manufacturer, a property more important even than in the British dominions.” J. Lowry Whittle, ‘The Late Earl Cairns’ (1885-6) 11 *Law Mag & L Rev* (5th ser.) 133, 150.

⁵² Sir John Rolt’s Act, 1862.

⁵³ 10 Hare 467.

⁵⁴ (1855) 1 K & J 509; 69 ER 560.

⁵⁵ (1857) 4 K & J 747; xx ER 310.

⁵⁶ The Times, (May 31, 1860), p. 11.

⁵⁷ (1863) 1 H & M 259

⁵⁸ (1863) 1 H & M 264

⁵⁹ (1863) 1 H & M 447

⁶⁰ (1864) 33 LJ Ch 561 (ANATOLIA for liquorice).

⁶¹ (1866) LR 1 Eq Cas 518.

⁶² (1867) 36 LJ Ch 504 (refusing injunction in case of look-alike label for picalilly, because while the names of the product, shape of label and coat of arms were similar, the parts of label that customer was likely to look at—the names of the companies - were different).

⁶³ (1866) 36 LJ Ch 228 (refusing injunction to protect PATENT PLUMBAGO CRUCIBLE COMPANY on the basis that the Plaintiff had no patent).

⁶⁴ (1871-72) L.R. 5 H.L. 508.

⁶⁵ (1863) 1 De G. J. & S. 185

⁶⁶ (1863) 4 De G J & S 150

⁶⁷ (1864) 4 De G J & S 380.

⁶⁸ (1871-72) L.R. 5 H.L. 508.

⁶⁹ (1863) 32 LJ Ch 741.

⁷⁰ (1863) 32 LJ Ch 548.

⁷¹ (1863) 33 LJ Ch 371 (rights over imported wine bearing counterfeit VEUVE CLICQUOT insignia).

⁷² (1864) 33 Beav 578

Assurance Co., Ltd (1864),⁷³ and *Banks v Gibson* (1865);⁷⁴ Lord Cranworth LC in *Seixo v Provezende*,⁷⁵ and *Leather Cloth*.⁷⁶ This flurry of cases not merely led to an elaboration of the applicable principles and rules, but also produced a level of consistency and coherence that had prior to that been difficult to establish, with judgments of different courts, and different personnel appearing very sporadically.⁷⁷ And in the period from 1862 to 1882, the House of Lords heard five cases on trade marks: *Leather Cloth*,⁷⁸ *Wotherspoon v Currie*,⁷⁹ *Singer Machine Manufacturers v Wilson*,⁸⁰ *Johnston v Orr-Ewing*;⁸¹ *The Singer Manufacturing Company v Loog*.⁸² By the time of the latter case, Lord Selborne LC could refer to “the ordinary principles applicable to trade-marks and trade-names”, and Lord Blackburn agreed that the relevant law was “well-settled.”⁸³

Alongside judicial activity, commentators were beginning to collect, organise, and codify the decisions and statutes: beginning with Edward Lloyd’s treatise in the early 1860s,⁸⁴ Harry Bodkin Poland’s commentary on the 1862 Act, Leone Levi’s

⁷³ (1864) 33 Beav 548.

⁷⁴ (1865) 34 Beav 564.

⁷⁵ (1866) LR 1 Ch App 192.

⁷⁶ *Leather Cloth v. American Leather Cloth Co.* (1865) 11 HLC 523.

⁷⁷ Another notable feature of the cases in the 1860s is the consistency of the advocates: with Sir John Rolt appearing in ten of the reported cases (*Welch v Knott*, *Mappin*, *Woollam*, *Braham*, *M’andrew*, *Colonial life*, *Ainsworth*, *Edelsten*, *Leather Cloth and Seixo*); Hugh Cairns in seven (*Welch*, *Mappin*, *Moet*, *M’Andrew*, *Edelsten*, *Leather Cloth and Seixo*); and Roundell Palmer in four (*Hall*, *Colonial*, *Ainsworth and Wotherspoon*). Although Rolt’s judicial career was limited (he was made Lord Justice of Appeal in Chancery in 1867 but resigned the following year), Cairns, a Tory, and Roundell Palmer, a Liberal, were later to be Lord Chancellors (Cairns, in 1868, and from 1874-80; Palmer was Chancellor from 1872-4, and again from 1880-1885). In this capacity, Cairns introduced the 1875 Registration Bill into Parliament, and gave judgements in the House of Lords decision in *Singer v Wilson*; Roundell Palmer, as Lord Selborne LC, was the leading judge in two House of Lords decision, *Johnston v Orr-Ewing* (1882) 7 HL 219; *The Singer Manufacturing Company v Loog* (1882) 8 HL 15. *Maxwell v Hogg*.

⁷⁸ (1872) LR 5 HL 518 (holding infringement of plaintiff’s trade mark GLENFIELD for starch when GLENFIELD used prominently on label with CURRIE ROYAL PALACE STARCH. Although the plaintiff was no longer located in Glenfield (a village of 60 inhabitants) and the defendant had itself located there, the term was not being used as part of an address).

⁸⁰ (1877) LR 3 HL 376 (holding that first instance court was wrong to conclude that there was no prima facie case of infringement of (non-registered) trade mark SINGER where defendant had used on price lists to describe its sewing machines).

⁸¹ (1882) LR 7 HL 219 (holding there to be infringement of mark comprising label bearing elephants and flag when used in relation to thread destined for Indian market).

⁸² (1882) LR 8 HL 15 (holding no infringement of (non-registered) SINGER mark by use on internal price lists accessible only to retailers (rather than consumers) who, evidence indicated, understood the term to be being used to describe a combination of features in a sewing machine).

⁸³ (1882) LR 8 HL 15, 17, 29.

⁸⁴ *The Law of Trade Marks* (1862). Wadlow calls this “an impressive and forward-looking analysis”. Note also the paper by Professor Leone Levi, of King’s College, London, ‘On Trade Marks’ (1859)

International Commercial Law,⁸⁵ followed by more substantial treatises by Ludlow and Jenkins and Frank Mantel Adams in the early 1870s.⁸⁶ Following the 1875 Act, a number of texts were published commentating on the registration system: James Bryce offered a supplement to Ludlow and Jenkins work,⁸⁷ and Adams reissued his text with a copy of the Act;⁸⁸ J. Seymour Salaman, solicitor to the Trade Mark Protection Society, which had lobbied for the Act, issued *A Manual of the Practice of Trade Mark Registration*;⁸⁹ while John Bigland Wood,⁹⁰ Charles Drewry,⁹¹ Lionel B Mozley,⁹² Edward Morton Daniel,⁹³ and Lewis Boyd Sebastian, offered yet more texts, the latter establishing itself as the market-leader and going into five editions.⁹⁴

A fourth environment in which trade marks law was coming under scrutiny was within the Foreign Office, which started to take a keen interest in the laws of foreign countries.⁹⁵ From the 1850s trade marks came to be one of the topics considered in bilateral trade negotiations, so-called treaties of ‘freedom, commerce and navigation’.⁹⁶ This interest is reflected in the government publications (or ‘blue books’ as they were widely-known): in 1872, there was there published a *Report*

JSA 262; and subsequent papers by E.M. Underdown, ‘On the Piracy of Trade Marks’ (1866) 14 JSA 370; and Wybrow Robertson, ‘On Trade Marks’ (1869) 17 JSA 14.

⁸⁵ L. Levi, *International Commercial Law* (London: V & R Stevens, 1863) Ch 20.

⁸⁶ H. Ludlow & H. Jenkins, *A Treatise on the Law of Trade-Marks and Trade-Names* (London: W. Maxwell & Son, 1873); F.M. Adams, *A Treatise on the Law of Trade Marks* (London: 1874).

⁸⁷ J. Bryce, *The Trade Marks Registration Acts 1875 and 1876* (London: William Maxwell & Sons, 1877).

⁸⁸ F.M. Adams, *A Treatise on the Law of Trade-Marks: with the Trade-Marks Registration Act of 1875 and Rules* (London: Butterworths, 1876).

⁸⁹ J. S. Salaman, *A Manual of the Practice of Trade Mark Registration* (London: Shaw and Son, 1876).

⁹⁰ J.B. Wood, *The Law of Trade Marks* (London: Stevens, 1876).

⁹¹ Charles Stewart Drewry’s, *The Law of Trade Marks* (London: Knight, 1878).

⁹² L.B. Mozley, *Trade Marks Registration. A Concise View of the Law and Practice* (London: 1877).

⁹³ E. M. Daniel, *The Trade Mark Registration Act 1875* (London: Stevens & Haynes, 1876).

⁹⁴ L.B. Sebastian, *The Law of Trade Marks and their Registration* (London: 1878). Sebastian went into 5 editions: 1884, 1890, 1899 (with Harry Baird Hemming); 1911 (with Harry Baird Hemming and Skinner Raymond Sebastian). Note also L.B. Sebastian, *A Digest of Cases of Trade Mark, Trade Name, Trade Secret, Goodwill etc* (London: Stevens & Sons, 1879) and Sebastian’s, *The Law of Trade Mark Registration* (London: Stevens, 1906), issued in a second edition by F.E. Bray and J.Q. Henriques in 1922. Kerly, the leading practitioner text today, first entered the field in 1894: D.M. Kerly, *The Law of Trade-Marks and Trade Name, and Merchandise Marks* (London: Sweet & Maxwell, 1894) (with further editions in 1901, 1908, 1913, 1923 and 1927).

⁹⁵ The Colonial and India Office’s were also significant. Note also the references to the Indian Penal code, (1861) *Sol Jo & Rep* 3 and the reproduction of the relevant provisions at ‘Trade Marks and Property Marks’ (1861) *Sol Jo & Rep* 14..

⁹⁶ Treaty of Commerce and Navigation with Russia (St Petersburg, January 12, 1859); Treaty of Commerce with France (Paris, January 23, 1860); Treaty of Commerce and Navigation with Belgium (London, July 23, 1862); Treaty of Commerce and Navigation with Italy (Turin, August 6, 1863); Treaty of Commerce with the Zollverein (Berlin, June 30, 1865); Treaty of Commerce with Austria

Relative to Legislation in Foreign Countries on the Subject of Trade Marks,⁹⁷ along with a second Report on *Treaty Stipulations between Great Britain and foreign Powers on the Subject of Trade Marks*.⁹⁸ Within a relatively short time, this activity would intensify, and consideration would be given to the formulation of a multilateral treaty, ultimately resulting in the Paris Convention on Industrial Property in 1883.

It was in these four environments that the British legal system seems to have begun to develop its conception of trade marks law. Of course, what was at stake differed significantly from domain to domain, but – importantly – none of these environments operated in isolation: appreciation of foreign law fed into calls for legislative change,⁹⁹ legislative reform fed into commentaries, commentaries into case law (and vice versa); and judicial opinion into legislative reform. Two examples of how these parallel developments were intertwined can be seen in the persons of two key figures: Lords Westbury and Cairns. Richard Bethell, then a barrister and MP, chaired an early meeting of the Royal Society of Arts at which Leone Levi gave a paper highlighting deficiencies in the protection of trade marks,¹⁰⁰ and later as Lord Chancellor gave ground-breaking decisions widening and strengthening protection.¹⁰¹ Lord Cairns, who, as Lord Chancellor, introduced the 1875 Trade Mark Registration Act into Parliament had himself frequently appeared in trade mark litigation, first as a barrister and then as a judge, and had also been a member of the 1862 Select Committee.¹⁰²

3. The Debate over the Nature of A Trade Mark

(Vienna, December 16, 1865); Treaty of Friendship, Commerce and Navigation with Columbia (London, February 16, 1866)

⁹⁷ C. – 596. Setting out the laws of Austria, Belgium, Denmark, France, Germany, Netherlands, Portugal, Russia, Spain, Sweden, Switzerland, Turkey and the United States.

⁹⁸ Setting out treaties with Austria, Belgium, Colombia, France, Italy, Russia and the Zollverein.

⁹⁹ Hansard, (1861) 161 *Parliamentary Debates* 327 (February 12, 1861) (Lord Chancellor stating that “In most other countries the forging of such marks was a crime...”). On French trade mark law, contemporaries refer to: M. Rendu, *La Concurrence déloyale*, Barrault, Gouget & Merger’s *Dict de droit commercial art nom*: see e.g. EM Underdown, ‘On the Piracy of Trade Marks’ (1866) 14 *JSA* 370; Lloyd (1861) *Sol Jo & Rep* 614.

¹⁰⁰ ‘Fifteenth Ordinary Meeting’, (1859) *JSA* 262. Bethell made a number of comments at the end of Levi’s talk emphasising that counterfeiting “is in effect theft...The thief obtains at once the fruits, probably, of a life of labour, invention and industry...”.

¹⁰¹ Writing in 1864 the *Solicitors Journal* welcomed Lord Westbury’s contribution to the jurisprudence relating to trade marks, asserting that “under his authority, the extent of the jurisdiction of courts of equity in granting injunctions has been defined in a broad and philosophical manner.” ‘Trade Names and Marks’ (1864) *Sol Jo & Rep* 175, 177.

¹⁰² Though he does not appear to have attended a single meeting of its proceedings.

Rather like the situation with the concept of a “brand” today, in 1860 there was no “legal” conception of a trade mark: to the extent that the term had meaning, it was as a description of a particular commercial artefact or insignia: the legal system at this stage building its categories and actions around more general notions, such as deceit, fraud, misrepresentation or cheat,¹⁰³ or specific trades or products. This meant that the identification of what was a “trade mark” was, at mid-century, of little consequence.¹⁰⁴ Or as barrister William Hindmarch explained to the Select Committee the term ‘trade mark’ “an improper term, except in Hallamshire” (that is, a six mile radius of Sheffield).¹⁰⁵

Over the next thirty years, as the legal system began to treat the concept of a “trade mark” as a term of art, carrying legal consequences, the term became highly contested. This process of legal definition really began with the formulation of the Bills in 1861 and 1862, and the subsequent Select Committee. Virtually everyone agreed that the laws preventing the fraudulent use of “trade marks” needed to be strengthened and the prevalent assumption seemed to be that some law – whether based on criminalisation, registration or property – should apply to use of marks in all trades. Trade-specific legislation was seen as lacking in principle, irrational and introducing unnecessary and undesirable distinctions: a modern law should be general and applicable to all trades.¹⁰⁶ In drafting laws regulating the use of “trade marks” it was necessary to determine exactly what was meant by that term – as Milner Gibson, President of the Board of Trade noted in the Commons, “[t]he question which, under the circumstances, naturally suggested itself was, *what was a trade mark* [?]” (emphasis added).¹⁰⁷

¹⁰³ Some opposed the shift from ‘fraud’ to ‘trade mark’: see Crauford, (1862) 165 Parliamentary Debates 770 (Feb 26, 1862).

¹⁰⁴ One exception to this would have been when a trader sought to transfer its business and trade marks.

¹⁰⁵ Select Committee (1862), Q. 2757 per W. Hindmarch (“the law at present in existence is a law to prevent cheats generally, and not merely to prevent the using or the pirating of trade marks, which is an improper term, except in Hallamshire...”)

¹⁰⁶ One commentator asked, rhetorically, whether “the makers of pins or needles, powder or shot, hair-dye or Eau-de-Cologne are not entitled to precisely the same protection, and by the use of the same means, as the makers of knives and forks, or a ship’s anchor?” Anon, ‘Proposed Alterations in the Law of Trade Marks’ (1861) *Sol Jo & Rep* 3. For this reason it was argued that the law must go beyond stamping or marking could to encompass marking of labels and packages.

¹⁰⁷ (1862) 165 *Parliamentary Debates* 446.

For those proposing protection only with registration, significantly greater precision seemed to be required.¹⁰⁸ This was because certain assumptions were being made about the nature, role and effect of registration.¹⁰⁹ On the assumption that registration was going to delineate a field of exclusivity, then it was perceived to be important that the field be established with clarity and certainty through some form of representation. Such a representation necessarily involved decontextualisation: the sign protected would have to be extracted from its usual environment (whether a wrapper, or stamped into a knife blade, or featured on the end of a piece of cloth) and re-presented in a register. In turn, registration required that the meaning and significance of the mark necessarily be inherent in the representation itself, rather than from its relation to other signs, images, shapes, or get up. Accordingly, the definition of trade marks (or at least, registrable trade marks) had to be limited to matter that traders could identify *ex ante* as worth protecting, and which could be represented in a meaningful way.

That said, the legislative arena was not the only one in which legal consequences were deemed to flow from designation as a mark: at almost exactly the same stage in dealing with equitable protection against misrepresentations in trade, Lord Westbury LC differentiated between “a trade mark properly so called” and other insignia.¹¹⁰ It is perhaps no co-incidence that Lord Westbury should have been the first to

¹⁰⁸ A broad definition of registrable trade marks might be problematic bureaucratically, and have undesirable legal consequences. Proponents of registration, such as Ryland, seemed to have thought the Registry would not work as well were it “so very large”: Select Committee, Q. 737 (Ryland). See also Alfred Marten (for Mr Hermon), 226 *Parliamentary Debates* 703-4 (Aug 7, 1875) stating “he wished to call attention to the difficulty of getting a proper definition of the term ‘trade mark’. There had been proposed various definitions, but none which would be effectual and comprehensive for the purposes of a statutory registration of trade marks. . . . He really thought it would be better for the purposes of registration not to undertake the difficult task of definition, but to simply use the term ‘trade mark’ and leave the definition to the ordinary Courts of Law.”)

¹⁰⁹ Cf. The views of William Hindmarch, who opposed a registration system. Hindmarch observed that if rights were based on “use” but registration was based on some sort of act of “representation” then the necessary gap between “representation” and “reality” would mean that third parties could not rely on the representation. Alternatively, if following registration the trader’s rights were to be based on the representation then it followed that the act of representing the mark would have altered the very nature of the subject matter that was protected. Select Committee, Qs 1881; 2997 (Hindmarch).

¹¹⁰ *Hall v Barrows* (1863) 4 De GJS 150, 157 (permitting transfer of such a mark with business and iron works). (“that is, a brand which has reputation and currency in the market as a well-known sign of quality”). Note also, *Leather Cloth v. American Leather Cloth Co.* (1865) 11 HLC 523, where Lord Westbury described as the plaintiff’s symbol as “in reality an advertisement of the character and quality of their goods” not something which has “hitherto been properly designated by” the term trade mark (546). Lord Kingsdown, at 538, said that what “is usually meant by a trade mark” is a “symbol or emblem” which has by use come “to be recognised in trade as the mark of the goods of a particular person”.

distinguish between “trade marks” and other misrepresentations in trade, because it was he who was advocating that trade marks be viewed as “property”. As with registration, the proposal that certain signs be treated as “property” seemed to require that there be an identifiable, distinct, autonomous object and Lord Westbury gradually began to clarify what he understood to be the defining characteristics of trade marks.¹¹¹

However, judicial definition and categorisation of signs was not necessarily tied to adoption of a proprietary understanding of (what we now call) passing off. The process of definition was also a predictable response to the sheer proliferation of cases: the judiciary were starting to elaborate rules from holdings in particular instances, and the type or form of the misrepresentation was treated as a relevant factor in developing such rules. Grappling for labels, the judiciary would refer to ‘real trade marks’, and even began to draw up a taxonomy of marks carrying different legal effects.¹¹² These processes of defining mark were in turn aided by the work of commentators and textbook writers. Many commentator felt it was necessary at least to define their subject and explain why it deserved its own treatment. As Underdown wrote “the accurate definition of a Trade Mark properly so-called, is of the highest importance to the due understanding the subject and its difficulties.”¹¹³ Likewise, Sebastian’s text asked rhetorically “with what class of objects is this branch of the law concerned?” and proceeded to attempt to distinguish “true trade marks from other marks”¹¹⁴

3 The Meaning of trade Mark

¹¹¹ Cf Kerly (1894) 27 (“judges have but seldom attempted to state precisely what a trade mark is”).

¹¹² *Singer Manufacturing v Wilson* (1876) LR 2 Ch Div 434, 439 Jessel MR “when they say that the use of the word ‘SINGER’ has become and is a trade-mark of the Plaintiffs, it is said in some extraordinary and unusual sense of the word ‘trade-mark’, they having a proper trade-mark, which is one very well known.” At 441 he divides cases of false representations into two classes: true trade marks (“a mark which shews that the goods are made by some particular maker”) (441) where intent to defraud or ignorance that the sign was a trade mark are immaterial; and a second class ‘cases of fraud’ where without using the plaintiffs mark there is a representation that the goods are those of the plaintiff (443). James LJ, on appeal, at 451 approved the analysis, the division between “imitation of a trade-mark proper” and other false representations where a person “is passing off his goods as the goods of another person.”

¹¹³ EM Underdown, ‘On the Piracy of Trade Marks’ (1866) 14 JSA 370.

¹¹⁴ L.B. Sebastian, *The Law of Trade Marks and their Registration* (London: 1878) 14, 16.

Over the next decades a number of possible conceptions of the nature and function of a “trade mark” were suggested. Amongst the contested issues were questions of the form of trade marks: whether trade marks were confined to names or visual images and devices or encompassed words; there were also questions as to the manner in which “trade marks” were associated with goods – was a sign a trade mark only if it was impressed on goods, or could material associated with goods, such as labels, wrappers and bottles constitute trade marks; and finally, there were questions about which marks stamped on goods were “trade marks” and which were not; and whether trade marks functioned to indicate trade origin, geographical origin or quality (or something else). As we will see, these questions were not resolved by the 1875 Trade Marks Act, and the definition of trade mark (or registrable trade mark) continued to be debated well into the twentieth century – with statutory changes to the definition of registrable marks being made again in 1883, 1888 and 1905. Indeed, while aspects of the debates over the definition of trade marks are in many ways different to those of today, many of the concerns remain the same. Here I want to confine my discussion to two questions concerning what types of matter could be marks, and two concerning the meaning conveyed by the mark.

(a) Names

The first area of interest relates to names. It seems clear, at least from the submissions to the Select Committee of 1862 that many considered the name of a trader as the archetypal trade mark.¹¹⁵ This is perhaps not surprising: the existing trade-specific statutory regimes which covered linen, hops, and patentees (referred to above) had provided protection against counterfeiting of names used on goods and sometimes even compelled the marking of goods with the manufacturers names; while both the criminal law of forgery and civil law relating to trade misrepresentations had been invoked against misuse of (amongst others) BORWICK’S, VELNO’S,¹¹⁶ EVERETT’S,

¹¹⁵ This can be seen from the explanation of solicitor John Morris, that “Trade marks are not confined to the name of the manufacturer or owner, but extend, ...to the use of signs and marks of every conceivable kind..” See ‘On Fraudulent Trade Marks’, (1861) *Sol Jo & Rep* 820 reporting paper of John Morris given to the Metropolitan and Provincial Law Association, Worcester.

¹¹⁶ *Canham v Jones* 2 V&B 218 (VELNO’s vegetable syrup).

SYKES', RODGERS', MORISON'S. As Salaman observed in his 1876 treatise, "a man's name is still stronger trade mark than any that can be devised."¹¹⁷

What is more interesting about the perception of the name as the archetypal trade mark is that it points to a rarely notice conception of trade mark protection as founded in personhood. While English law may have declined to recognise a right of personality (and continues to do so today), the laws that were in the process of recognition in this period seem to have been informed by (even if they did not articulate) an idea of inherent right in a person's name. Indeed Potter, one of the members of the Select Committee, inquired of deponents whether they would "grant a mark without a name"¹¹⁸, and himself advocated that protection be confined to names and monograms accompanied by names.¹¹⁹ Others were open to recognising a broader notion of what could be protected, so as to include for example marks or devices, but largely on the basis that these were substitutes or proxies for names, signatures or addresses. As Arthur Ryland, a chief proponent of registration indicated, "[w]hat a crest or coat of arms is to a gentleman the trade mark is to the manufacturer."

If names were the archetypal trade marks, the question of their protection immediately pointed to two distinct difficulties. The first was the problem of reconciling the inherent right of one trader to gain protection for the use his name on goods and the inherent right of a trader of the same (or a similar) name to use his or her name. The courts had already encountered exactly such problems in applying the extended law of deceit (which we now label 'passing off'), and had resolved that if the use was *bona fide* the court would not interfere,¹²⁰ but if there was evidence of fraudulent intent the court would prevent further use of the name.¹²¹ However, the recognition that other

¹¹⁷ J. S. Salaman, *A Manual of the Practice of Trade Mark Registration* (London: Shaw & Sons, 1876) p. 11. Citing *Ainsworth*.

¹¹⁸ Select Committee Q 2684. Travers Smith responded that he would: while "a mark with a name would be far better, because that would indicate origin...many valuable existing marks are without names."

¹¹⁹ Select Committee Q 2181 (Potter).

¹²⁰ *Burgess v. Burgess* (1850) 3 De G M & G 896 (action by father who sold essence of anchovies under the name John Burgess and Son against his son, William Harding Burgess, for using name W.H. Burgess, and label Burgess's Essence of Anchovies failed, though Knight Bruce LJ recognised that the case would have been different had there been 'any circumstance of fraud.')

¹²¹ *Croft v Day* 7 Beav 84 (Day, surviving partner of Day and Martin, blacking manufacturers, successful against nephew, also called Dy, who had joined with a friend called Martin in the manufacture of blacking); *Holloway v Holloway* (1853) 13 Beav 209 (protection of manufacturer of HOLLOWAY'S PILLS AND OINTMENTS at 244 Strand against Henry Holloway who had set up business as

traders might legitimately use the same name as one already used by an existing trader was a problem for those who wanted trade marks to be seen as property, because the determination of the legitimacy of the use necessarily depended *upon its context*.¹²² Either the proprietary regime would need to be carefully calibrated to accommodate the special position of names (as it is in today's law – section 11(2)(b) of the Trade Marks Act 1994) or names – the archetypal marks – would need to be excluded from registration as such. And it was the latter course that was adopted in the 1869 Bill proposed the registration of marks that would be protected by law, other than “a name of a person, firm, or company only unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons”. Similarly, the definition of a trade mark successfully adopted in 1875¹²³ permitted only the registration of a name of an individual or firm “printed, impressed or woven in some particular and distinctive manner”; or “a written signature or copy of a written signature of an individual or firm”.¹²⁴

The perception that names were extensions of personhood threw up a second problem, that is, why such right should need to be based on registration. Indeed, there seems to have been quite widespread opinion that names were so special that a kind of inherent right existed warranting protection without formality, whereas other insignia such as emblems or devices should only be protected if used in trade or registered.¹²⁵

‘H. Holloway pills and ointments’ at 210 Strand using similar boxes, pots, labels and wrappers to those of the plaintiff. While recognising the defendant’s right to constitute himself a vendor of Holloway’s pills and ointments, Lord Langdale MR found there was clear evidence of fraudulent intent)

¹²² The 1862 Merchandise Marks Act, which imposed criminal liability only where there was a demonstration of fraudulent intent, had little problem in including names within the scope of its definition of trade mark.

¹²³ Alfred Marten (for Mr Hermon), 226 Parliamentary Debates 703-4 (Aug 7, 1875) (“The definition in the Act of 1862 in reference to the fraudulent imitation of trade marks was a most extensive one; but in the Bill it was proposed that there should be a far less extensive definition. A good deal of difficulty must arise from having one definition in relation to fraudulent imitation and another in reference to registration.”)

¹²⁴ Rather startlingly, Sebastian in his 1878 text asserted that “a name is in its very nature generic, and is properly applied to designate not one individual in the world, but it may be, many thousands to all of whom it is equally appropriate.” **Check: *Dence v Mason* 41 LTNS 573; *Dunnachie v Young C Sess Cas* 4th Ser X 874.**

¹²⁵ Select Committee Q 725 (Ryland) (“I would have registered simply the trade mark; it appears to us unnecessary to register the names of those manufacturers who have not adopted a mark...”); 732 (“no one can use the name of another, without authority, innocently.”) The Registration of Trade marks’ (1861) Sol Jo & Rep 839 reporting paper by Arthur Ryland (“By a trade mark I do not understand a manufacturers name, nor his label describing the quality of his wares, but a device used to indicate the person by whom, or the works where, the article bearing it was made or sold. What a crest or coat of arms is to a gentleman the trade mark is to the manufacturer.” Prohibiting fraudulent use of a name or label was in Ryland’s view desirable, “but the error was in including them under the term trade mark.”)

Accordingly, if a trade mark registry was to be employed, it should only cover emblems and symbols, not names, which should receive legal protection automatically.¹²⁶ The 1875 Act, as we have just noted, allowed only for protection of names in limited circumstances. However, in order to avoid prejudice to existing interests,¹²⁷ the Act also permitted the registration of “any special and distinctive word or words or combination of figures or letters used as a trade mark before the passing of this Act.” The Act, unfortunately, left unclear the relationship between registration, non-registrability and other forms of protection. For some time, at least some commentators thought that the common law protection was abolished and that protection arose under the Act alone.¹²⁸ Before long the courts clarified that marks that were not registrable could be protected at common law, and, in due course it was accepted that (whatever the statutory wording may have implied) the registration system operated without prejudice to common law protection of trade misdescriptions.¹²⁹ Any other conclusion would have, perversely, left traders who chose to use their own names (unaccompanied by a distinctive device) with virtually no protection under the civil law.

(b) Other indicia

Nearly all those involved in the processes of defining the concept of a “trade mark” accepted that it must cover “marks”, “symbols”, “emblems” and other visual “devices”. Such signs were precisely what had been protected under the regime operated by the Cutlers Company of Sheffield,¹³⁰ which was in many ways the model

¹²⁶ Yet others thought that both names and marks were equally deserving of protection and should be susceptible to registration, if such a system were adopted. Select Committee, Q 1111 (J Smith) (“the name in many instances might be a trade mark alone or in combination with a cipher”).

¹²⁷ Alfred Marten (for Mr Hermon), 226 *Parliamentary Debates* 703-4 (Aug 7, 1875) criticizing the definition in the 1875 Bill urged “that the greatest care should be taken not to prejudice valuable rights...”

¹²⁸ J. Salaman 7 fn (b) (“The clause renders registration virtually compulsory, and it would seem that all persons whose marks are of any value must register, otherwise their marks may be pirated with impunity); Daniel 37 (“Henceforth it will be necessary for any person intending to claim the exclusive use of a trade mark to register it at the office established by the Act”). Cf Bryce 16-7 (the power instituting criminal proceedings under the MMA in respect of the fraudulent imitation of an unregistered mark does not seem to be taken away by this section.”)

¹²⁹ *Great Tower v. Langford* (1888) 5 *RPC* 66 (injunction granted based on defendant’s use of similar packaging and colours to that of claimant); *Faulder v. Rushton* (1903) 20 *RPC* 477 (Vaughan Williams LJ stating that all s. 77 of the 1883 Act meant was that if a claimant wanted to rely on statute he or she must register).

¹³⁰ Higgins & Tweedale describe the two most famous such marks in this period as the Rodgers mark which comprised a Star and Maltese cross (originally granted to William Birks in 16820 and the I*XL

relied on by those seeking recognition of trade marks as properties by registration. Such “marks” had also been protected by the statutes relating to hall-marking, the marking of gun barrels, linens, and the protection of patentees. Indeed, such insignia were uppermost in the minds of many of those who discussed trade mark matters in this period. For example, one commentator in the *Solicitors Journal* identified “what is popularly known as a trade mark” with “a certain device representing some animal known to the actual or mythical world, which is impressed upon each article” – though few contemporaries would actually have limited the concept of marks to representations of animals.¹³¹

While there was no doubt that such emblems should be encompassed in the definition of a trade mark, contemporaries contested how much further a definition could – or should – go. The courts had indicated that the protection the law recognised against fraudulent misrepresentation could extend to misrepresentation by use of any and all indicia,¹³² and relief had been accepted as in principle available in relation to the fraudulent use of a particular name and livery for a bus service, as well as the use of cotton ties in particular place on fabric.¹³³ John Polson, of the starch-maker Brown and Polson, giving evidence to the Select Committee said he wanted a means of “claiming property in trade marks, and in the general features of the packet, or style of getting up, and in the name of the article.”¹³⁴ And Adams, in his textbook on trade marks,¹³⁵ defined a trade mark as “any symbol, or mark, or name, or other indication” including a “mode of tying bundles of goods or of peculiarly shaped bottles or boxes exclusively associated with the plaintiff’s manufacture or business” However, as far as registration was concerned, little consideration seems to have been given to protection of shapes, get-up or what we now call “exotic” marks. Perhaps those

mark used by George Wolstenholm & Sons, originally granted to William Smith in 1787. ‘Asset or Liability? Trade Marks in the Sheffield Cutlery and Tool Trades (1995) 37 *Business History* 1, 6.

¹³¹ Anon, ‘Proposed Alterations in the Law of Trade marks’ (1861) *Sol Jo & Rep* 3.

¹³² In *Perry v. Truefitt* (1842) 6 Beav 66; 49 ER 749, Lord Langdale, the Master of the Rolls outlined the basic principle of equitable in the following terms (at 73): “A man is not to sell his goods under the pretence that they are the goods of another man... He cannot therefore be allowed to use names, marks, letters or other indicia, by which he may induce purchasers to believe that the goods which he is selling are the manufactures of another person...”

¹³³ *Knott v. Morgan* (1836) 2 Keen 213 (imitation of overall trade dress of claimant’s omnibus business, including livery of staff gave rise to injunction, though this was confined to “names, words or devices” on its buses which were colourable imitations of the claimant’s); *Woollam v Ratcliff* (1863) (tying of silk).

¹³⁴ Select Committee Q. 1971 (Polson).

¹³⁵ F.M. Adams, *A Treatise on the Law of Trade Marks* (London: 1874) 8.

seeking protection were few, and the problems associated with representing such marks so transparent, that interested traders were content enough to rely on whatever protection the common law and criminal provisions provided in cases of real fraud.

However, controversy did surround the extent to which words could or should be protected as trade marks. Certainly, words had been protected at common law. In *Perry v Truefit*, Lord Langdale MR had considered the phrase “MEDICATED MEXICAN BALM” in principle protectable, and other cases recognised the possible protection of the words SOLID-HEADED PINS,¹³⁶ THE EXCELSIOR WHITE SOFT SOAP,¹³⁷ COCOATINA,¹³⁸ PESSENDEDE, as well as geographical names such as GLENFIELD and ANATOLIA.¹³⁹ Some of the judges had begun to differentiate between protectable and unprotectable words, sketching taxonomies of marks. For example, when holding that ‘COLONIAL LIFE ASSURANCE’ was not the exclusive property of the first trader to employ the phrase, Sir John Romilly MR sought to categorise signs as “distinctive marks”, “symbolical cases” and, unprotected, “descriptive terms”.¹⁴⁰ In *Leather Cloth Co v American Leather Cloth* (1865),¹⁴¹ the claimant claimed protection of the court for a mark comprising a circle including the words “CROCKETT INTERNATIONAL LEATHER CLOTH Co. EXCELSIOR. JR & CP CROCKETT & Co MANUFACTURERS, NEWARK HJ USA WEST HAM ENGLAND”. (The defendant’s “logo” was a semi circle including the words “AMERICAN LEATHER CLOTH COMPANY. SUPERIOR, LEATHER CLOTH MANUFACTURED BY THEIR MANAGER LATE WITH JR & CP CROCKETT 12 YDS OLD KENT ROAD, LONDON.”) Lord Kingsdown said that what “is usually meant by a trade mark” is a “symbol or emblem” (rather than words) which has by use come “to be recognised in trade as the mark of the goods of a particular person”. Lord Westbury averred: “I ought to have regarded this affix to the Plaintiff’s goods, which is here denominated a trade mark, as something which, according to the anterior usage and applications of the words “trade mark”, by no means resembles or comes within the description of anything that has hitherto been properly designated by that

¹³⁶ *Edelsten v Vick* 11 Hare 78.

¹³⁷ *Braham v Bustard* (1863).

¹³⁸ *Schweitzer v. Atkins* (1868) 37 LJ Ch 847 Malins VC (Schweitzer’s cocoatina or anti-dispeptic cocoa).

¹³⁹ *M’Andrew v Basset* (1864) 33 LJ Ch 561 (ANATOLIA for liquorice).

¹⁴⁰ *Colonial Life Assurance Co v Home and Colonial Life Assurance Co* (1864) 33 Beav 548.

¹⁴¹ *Leather Cloth v. American Leather Cloth Co.* (1865) 11 HLC 523, 538 per Lord Kingsdown.

name...My Lords, what is here called by the Appellants a trade mark, is, in reality, an advertisement of the character and quality of their goods”.

While the judges may have made progress in gradually differentiating between the protection afforded to various words depending upon the meaning the words conveyed when used in specific (and known) contexts,¹⁴² the proponents of property in marks faced a much more difficult task. If the registration of a word was to be permitted, and the consequence of such registration was to be that the registrant had the exclusive right to use the word on specified goods, it would be necessary to produce a mechanism of determining in advance (and without context) the meaning of any words for which registration was sought. Moreover, even with the benefit of a categorical scheme indicating which marks should be registrable, the operation of such a system would necessarily involve investing some low-level administrator with the power to accept or refuse registration. An additional worry was that such a broad system would lead to a proliferation of rights or properties. One merchant giving evidence to the Select Committee argued that protection should be limited to devices.¹⁴³ This reflected a real fear of a multiplication of protected marks which could render merchants liable, and a consequent desire that wholesalers and retailers need only be vigilant about the use of particular kinds of sign.¹⁴⁴ He objected to the “net being too wide” and a “flooding of the most ridiculous things”.¹⁴⁵

Even proponents of a registration system such as Arthur Ryland seemed to recognise the legitimacy of some of these fears. He proposed that registration be limited to devices, so that terms such as ‘medicated balm’ and ‘solid-headed pins’ that had been protected in earlier case-law would escape the registration system. He averred that “it

¹⁴² Including the idea of secondary meaning of terms whose primary meaning is descriptive: Lord Westbury in *Wotherspoon v Currie*.

¹⁴³ Select Committee, S Morley – trade mark should be limited to device 2372 concern about “the net being too wide” (2397) “a flooding of the most ridiculous things” (2394) “The expression ‘trade mark’ shall include any device lawfully used by any person to denote any chattel’ (2396).

¹⁴⁴ See also Select Committee, Q. 2362 (Dillon).

¹⁴⁵ In this respect it is of interest that the 1869 Bill would have prohibited the registration of more than one trade mark for the same description of goods”: Trade Marks Registration Bill, (1868-9) *Parliamentary Papers*, 5 Bills, clause 12. The unsuccessful 1873 Bill which followed the 1869 Bill in many respects abandoned this limitation.

was just and wise to exclude all such names. It appears to me unfair and contrary to public policy to allow any one house the exclusive right to an adjective.”¹⁴⁶

Ryland’s approach was ultimately that adopted in the 1875 Registration Act. Section 10 allowed for registration of “a distinctive device, mark, heading, label or ticket” to which there might be added “any letters, words, or figures, or combination of letters, words or figures” but did not offer protection for words, as such – no matter whether they were invented, fancy or non-descriptive. As if to emphasise this, the saving for acquired rights permitted the registration of “any special and distinctive word or words or combination of figures or letters used as a trade mark before the passing of this Act.” Many marks which were thus in fact distinctive (such as words that were adopted and became distinctive after 1875) could not be registered.¹⁴⁷ The limited definition became the subject of litigation,¹⁴⁸ and criticism.¹⁴⁹ Only six years later the view was widely held that a trade mark consisting of a fancy name [was] of far greater value than any device”.¹⁵⁰

(c). How did “trade marks” differ from other markings on goods?

Perhaps the most interesting aspects of the debates over the development of a definition of “trade mark” in this period related to how a trade mark could be differentiated from other signs, symbols and literature associated with products. As with “the impressions upon a piece of gingerbread”,¹⁵¹ not all marks on products could be conceived as or understood as “trade marks.” But what criterion differentiated between those impressions on a piece of gingerbread that were accidental, those that were decorative, and those that were “trade marks”? Manchester

¹⁴⁶ ‘The Registration of Trade marks’ (1861) *Sol Jo & Rep* 839 reporting paper by Arthur Ryland.

Ryland observed that this was the law in Prussia too.

¹⁴⁷ JE Evans-Jackson, ‘The Law of Trade Marks’ (1899) 47 *JRSA* 563, 565 (“the Act of 1875 contained one great defect in that it did not provide for the registration or protection of word marks... The greatest dissatisfaction resulted from this....”)

¹⁴⁸ AEILYTON case.

¹⁴⁹ E. Johnson, Honorary Secretary to the London Trade Marks Committee, ‘Trade Marks’ (1881) 29 *JSA* 493 (elaborating case law of word marks between 1875 and 1881).

¹⁵⁰ Johnson, ‘Trade Marks’ (1881) 29 *JSA* 493, 501.

¹⁵¹ Select Committee, Q. 1209 (J. Smith). The judiciary also struggled when dealing with material on goods that did not have the classic features of trade marks. In *Leather Cloth v. American Leather Cloth Co.* (1865) 11 HLC 523, at 546, Lord Westbury described the subject of the litigation as “in reality an advertisement of the character and quality of their goods” not something which has “hitherto been properly designated by” the term trade mark.

traders objecting to an early version of the Merchandise Marks Bill had made the point that “it is utterly impossible to ascertain in most cases, whether any trade mark, or the alleged trade mark is interfered with, or even whether the mark is intended as a trade mark or not”.¹⁵² And at least one member of the 1862 Select Committee (who himself decided to give evidence), Edmund Potter, a calico printer, took the view that trade marks comprised “all those things... which embody some amount of design upon them.”¹⁵³ Questioned by Roebuck about the distinction between trade marks and designs (already protected under a registration system), he responded that he considered it “all the same.... I cannot separate them.”¹⁵⁴

Those that sought to distinguish between the various markings that could adorn products so as to identify which were trade marks, tended to focus on the function of each mark: trade marks might be in the same (ontological) form (words, colours etc) as other signs, yet what made a sign a trade mark was how it functioned or how it was understood. For example, the Chairman of the Select Committee, John Arthur Roebuck, suggested to the witnesses George Wilkinson, Master Cutler of the Cutler’s Company that a trade mark was an emblem “impressed upon a manufacture *for the purpose of denoting* that the manufacture has been produced by a certain person.”¹⁵⁵ Four years later, the solicitor Underdown, likewise articulated his view of “[t]he accurate definition of a trade mark” as “any mark, name, figure, letter or device employed *to denote* that any article of trade, manufacture, or merchandize, is of the manufacture, workmanship, production or merchandize of the person using it with or upon goods.”¹⁵⁶ While differing slightly as to detail, both these functional definitions would be familiar to trade-mark lawyers today for whom the classical understanding of a trade mark is that it is a sign which operates (or is intended to operate) *to denote* trade origin.

While the definition of the function of trade marks in this period was in many ways not dissimilar to how such signs would be described today, two aspects are particularly worthy of note. The first relates to the specific content of the indication of

¹⁵² See ‘On Fraudulent Trade Marks’, (1861) *Sol Jo & Rep* 820, 821, quoting from a petition by the wholesale houses of Manchester against the Bill.

¹⁵³ Select Committee, Q. 2183 (Potter).

¹⁵⁴ Select Committee, Q. 2211, 2215 (Potter).

¹⁵⁵ Select Committee, Qs 1726-8 (G. Wilkinson).

trade origin: for it was contested whether trade marks were (or should be confined to) marks indicating workmanship or manufacture, or were indications of the entity that produced the goods, or even just that the goods had been approved by whoever happened to be the trade-mark owner.

The London merchant J. Dillon, thought a trade mark was “a mark that is affixed to goods, which identifies those goods as being *made by* a particular man”.¹⁵⁷ He said that a trade mark should not be used by a person other than the manufacturer because

“the trade mark is referred to as a mark implying a certain fact, that it is an established manufacture by certain man or firm, at a certain place. *If you alter .. the person, that destroys the mark.* I have heard of people attempting to sell their trade marks, but I should as soon think of a soldier selling his medal.”

Taking his analysis to its logical conclusion, he would have opposed even the use of the same mark by successors to a partnership.¹⁵⁸ Others had a broader idea of origin. Giving evidence to the 1862 Select Committee, William Smith, solicitor and secretary of the Sheffield Chamber of Commerce, and John Smith, Iron founder and President of the Sheffield Chamber of Commerce, took what we would recognise as the modern position: trade marks “shows that the goods are made by some particular person or by some other person whom he has authorised to make for him”.¹⁵⁹ Another lawyer, Underdown was keen to emphasise that marks could be of value to the merchant or wholesale dealer so as to indicate “care in their selection”: he defined trade marks as marks denoting “that any article of trade, manufacture, or merchandize, *is of the manufacture, workmanship, production or merchandize of the person using it with or upon goods.*”¹⁶⁰ Yet others suggested that a trade mark “may signify no more than ...that the article to which it is affixed has passed into the market through the hands of the person entitled to use the mark, and finally may come to be regarded by the public as a mere guarantee of quality”.¹⁶¹

¹⁵⁶ EM Underdown, ‘On the Piracy of Trade Marks’ (1866) 14 *JSA* 370.

¹⁵⁷ Select Committee, Q. 2286 (Dillon); Q. 2336 (Dillon, agreeing with Potter that a trade mark is “a means of communicating to the buyer the name of the maker of the article”).

¹⁵⁸ Select Committee, Q. 2343 (Dillon).

¹⁵⁹ Select Committee, Q. 616 (William Smith); Qs 1225-35 (J.J. Smith).

¹⁶⁰ EM Underdown, ‘On the Piracy of Trade Marks’ (1866) 14 *JSA* 370. The 1862 Merchandise Marks Act defined the objects of trade mark protection broadly as any mark “lawfully used by any person to denote any chattel, or (in Scotland) any Article of Trade, Manufacture or Merchandise to be ...the Manufacture, Workmanship, Production or Merchandise of such Person...or...to be an Article or Thing of any peculiar or particular Quality or Description made or sold by such Person”

¹⁶¹ Ludlow & Jenkyns (1873), p. 2.

A second aspect of the functional definitions employed in this period is of interest because it is one that seems very much to have been lost from today's trade mark law. While today commentators consider trade marks as indications of trade origin, those from the 1860s and 70s seem to have thought that a trade mark also indicated *where* a product was made. Arthur Ryland described a mark as "a device used by manufacturers to denote the person by whom, *or the place where*, the article bearing it was made." (emphasis added) Writing in 1874,¹⁶² F.M. Adams described a trade mark as "any symbol, or mark, or name, or other indication which when affixed to goods offered for sale in the market would convey to the minds of purchasers the impression that those goods were the manufacture of some person or firm, *or some particular place*." Lionel Mozley, solicitor, similarly defined a trade mark as indicating that an article or commodity "is made by a particular firm or person, *at a particular place or manufactory*, or is of a particular quality or description."¹⁶³ A similar definition had been adopted in the Indian Penal Code,¹⁶⁴ and in the Prussia law of 1851,¹⁶⁵ and had received judicial approval from Sir John Romilly in *Hall v Barrows* and Lord Cranworth LC in *Leather Cloth*.¹⁶⁶

This tendency to link indications of trade origin with indications of geographical origin looks odd to a commentator in the 21st century. The emphasis being placed on trade marks as indications of geographical origin may, in part, have reflected the fact that many traders marked their goods with the name and address of the place where the goods were made. Associations, then, might rapidly have been formed between particular (non-geographic) trade names and places of geographical origin. Moreover,

¹⁶² F.M. Adams, *A Treatise on the Law of Trade Marks* (London: 1874). See also L. Levi, *International Commercial Law* (1863) 598.

¹⁶³ L.B. Mozley, *Trade Marks Registration. A Concise View of the Law and Practice* (London: 1877), p.1.

¹⁶⁴ Article 478 of the Indian Penal Code 1860 defined trade mark as "a mark used for denoting that goods have been made or manufactured by a particular person or *at a particular time or place*, or that they are of a particular quality": 'Trade Marks and Property Marks' (1861) Sol Jo & Rep 14.

¹⁶⁵ According to Levi's *International Commercial Law* (1863) this prohibited the fraudulent marking of merchandise with "the name of the firm, and with the dwelling or manufacturing place of a Prussian manufacturer, producer or tradesman".

¹⁶⁶ (1862-3) 32 LJ Ch 548. Sir John Romilly MR considered whether the mark could be sold, and held it could not. He divided marks into two categories: those that "denote the spot where certain articles are manufactured" which "*might possess peculiar local advantages for the manufacture of the article...*" and those that "denote the persons by whom they are manufactured." In *Leather Cloth v. American Leather Cloth Co.* (1865) 11 HLC 523, Lord Cranworth LC defined the right to a mark as "the

it also reflected the fact that many consumers would have taken the geographical origin of the goods as an indication of their likely quality: non-geographical marks, such as names, could thus in the public mind be associated with the place where the goods were made and that, in turn, with the quality of the goods. As Adams explained, a trade mark “should in fact be an assurance to the public that they are reaping the benefit of some person’s superior skill, or *the peculiar local advantages of some place.*”¹⁶⁷ In contrast, while today one might associate Terry’s chocolate with York, or Cadbury’s with Birmingham, a consumer would not think that the quality of such manufactured goods depended on the location of its manufacture. Today, most manufacturing business are assumed to be highly mobile, employees from different locations equally capable and the quality (as opposed to cost) of production not related to geographical location.

In the 1860s, the question of whether a trade mark indicated the place of manufacture (as well as the trade origin) was not just relevant to the definition of a mark, but also was seen to have potentially significant legal implications. More specifically, in so far as a (non-geographic) trade mark indicated geographic origin, the question arose whether it became mis-descriptive to use the same mark in relation to any other geographical source. This had potentially significant consequences, either if the proprietor wanted to re-locate, or if the business was to be sold to a manufacturer in a different location.¹⁶⁸ Smith thought there was no misrepresentation by sale of a mark, even if the public expected a particular sort of product. The President of the Board of Trade, Milner Gibson asked him about whether he would object to a man who

exclusive right to use it for the purpose of indicating where, or by whom, *or at what manufactory*, the article to which it was affixed was manufactured”.

¹⁶⁷ F.M.Adams, 60. In *Hall v Barrows* (1862-3) 32 LJ Ch 548. Sir John Romilly MR explained that a “mark or brand which denotes goods manufactured at a particular place may be, and probably would be sold with the works themselves, and the mark would be, as it were, attached to the spot, to denote which it was first adopted, and *which might possess peculiar local advantages for the manufacture of the article...*”

¹⁶⁸ A related question of whether the key relationship was between mark and place had been raised as early as *Motley v Downham* (1837). There the dispute was over whether the mark “M.C.” which had been used to brand boxes of tin plates from a works at Carmarthen, had been purchased, with the goodwill of the business by a trader who then moved the place of manufacture 44 miles to Glamorganshire. A decade later the defendant commenced business at the Carmarthen works and marked their tin plates “M.C. Carmarthen”. The Vice-Chancellor had granted an injunction, but the Lord Chancellor, Lord Cottenham, discharged the order, giving the plaintiff leave to bring the case at law. He did not seem to think the case would have been problematic, except for the fact that the defendant was using a mark that had always been used by persons carrying on manufacture of tin plates at that works. He thought the issue “one of considerable nicety” whether a mark associated with a particular place could continue to be used by a person who operated out of that place.

hitherto had manufactured cigars in Havannah selling the right to use its mark to another trader who might make cigars in Ipswich.¹⁶⁹ Smith responded that he did not see this as enabling a fraud. In contrast, solicitor Arthur Ryland, one of the chief figures in the Chamber of Commerce movement for trade mark registration, was more disturbed. He described a mark as “a device used by manufacturers to denote the person by whom, *or the place where*, the article bearing it was made.” (emphasis added) He did not think marks should be transferred other than with the trade, but had real difficulty with Milner Gibson’s interrogation about whether a business in one geographical location should be permitted to sell its business and mark to a trader at a different location.¹⁷⁰ Others were more categorical: according to Wright, a Birmingham Button manufacturer, “the trade mark should not travel.”¹⁷¹

Conclusion

In 1860 there was no such thing as a legal concept of “trade mark”. By 1875 there were at least three legal conceptions of trade marks: the very broad notion adopted in section 1 of the Merchandise Marks Act 1862,¹⁷² the tentative definition of trade mark being developed in the context of common law protection (later called passing off), and the narrow definition inserted in the Trade Mark Registration Act 1875.¹⁷³ While the adoption of different definitions of trade mark by the legislature, not surprisingly, drew criticism,¹⁷⁴ it is easy to understand the desire to adopt a cautious approach to

¹⁶⁹ Select Committee, Q. 620 (Milner Gibson to W. Smith).

¹⁷⁰ Select Committee, Q. 908 (Ryland).

¹⁷¹ Select Committee, Q. 1075 (J.S. Wright).

¹⁷² The 1862 Merchandise Marks Act defined the objects of trade mark protection broadly – as to the type of subject matter and its communicative content: “the expression ‘Trade Mark’ shall include any Name, Signature, Word, Letter, Device, Emblem, Figure, Sign, Seal, Stamp, Diagram, Label, Ticket or other Mark of any other Description”... “lawfully used by any person to denote any chattel, or (in Scotland) any Article of Trade, Manufacture or Merchandise to be ...the Manufacture, Workmanship, Production or Merchandise of such Person...or...to be an Article or Thing of any peculiar or particular Quality or Description made or sold by such Person”

¹⁷³ In some respects the period is interesting because of the ideas that were mooted but not adopted.

One of these was that ‘trade marks’ were identifiers, rather like id codes or fingerprints. From this perspective, M. Henry in a paper to the Royal Society of Arts, argued that marks be confined to letters and numbers (excluding devices), so that each trade mark was “more distinctive, more substantial and therefore more secure; it would impart to it a sharply defined, and unmistakeable idiosyncasy”. Henry’s conception was of marks such as “A50” for beer. M. Henry, ‘Trade marks’ (1862) 10 *Journal of the Royal Society of Arts* 255. For the same idea see (1875) *JRSA* 567.

¹⁷⁴ Alfred Marten (for Mr Hermon), 226 *Parliamentary Debates* 703-4 (Aug 7, 1875) (“The definition in the Act of 1862 in reference to the fraudulent imitation of trade marks was a most extensive one; but in the Bill it was proposed that there should be a far less extensive definition. A good deal of difficulty

establishing rights over signs by registration. The adoption of registration would change the nature of trade mark protection, reinforcing emerging notions of the trade mark as the object of property, rather than as a component in a communicative context. Limiting the initial coverage of the registration system to specific types of signs seemed sensible given the impossibility of predicting confidently how the system would operate and what its impact would be. As Daniel explained in his treatise, “[I]t would seem to have been the object of the framers of the Act to define and restrict trade marks to within those limits which experience had proved to be the most generally useful and the most capable of protection.”¹⁷⁵ In fact, as David Higgins and Geoffrey Tweedale have described, the new system came in for considerable criticism, particularly from the Manchester cotton trade which sought immediate exclusion from the scope of the Act.¹⁷⁶ Initially, there were bureaucratic problems with the sheer volume of registrations.¹⁷⁷ In the medium term, both the scope of trade mark registration came to be expanded (in particular, to cover words), and the bureaucratic procedures adapted to accommodate the needs of particular trades and the specificities of their practices.

must arise from having one definition in relation to fraudulent imitation and another in reference to registration.”)

¹⁷⁵ E.M. Daniel, *The Trade Mark Registration Act* (London: Stevens & Haynes, 1876) p.40. Also noting that prior to 1875 “there were no legal restrictions in existence before upon what might be used as a trade mark.”

¹⁷⁶ D. Higgins & G. Tweedale, ‘The Trade Marks Question and the Lancashire Cotton Industry, 1870-1914’ (1996) 27 *Textile History* 207-228, esp. at 211. See also (1876) *Solicitors Journal* 402, Mar 18, 1876 (describing deputation from Manchester to Lord Chancellor complaining that the 1875 Act had been rushed through without giving an opportunity to provide evidence, stating that the Manchester traders were happy with the 1862 Act, and considered the 1875 law would impose excessive costs).

¹⁷⁷ (1879) 23 *Solicitors Journal* 819 (Aug 16, 1879) referring to case *Hazzupulo v. Kaufman* as revealing a backlog of 44,000 applications.